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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,476	04/19/2004	Kenneth B. Higgins	5615B	3281

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EXAMINER	
JUSKA, CHERYL ANN	
ART UNIT	**PAPER NUMBER**
1771	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/827,476	HIGGINS ET AL.	
	Examiner	Art Unit	
	Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,19-24,27-30,33-36,38,39,42,43 and 50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11, 19-24, 27-30, 33-36, 38, 39, 42, 43, and 50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's Amendment After Final filed January 9, 2007, has been entered. Claims 33-36 and 50 have been amended as requested. Claims 12-18, 25, 26, 31, 32, 37, 40, 41, and 44-49 have been cancelled. Thus, the pending claims are 1-11, 19-24, 27-30, 33-36, 38, 39, 42, 43, and 50.

2. The indicated allowable subject matter of the claims is withdrawn in view of the newly discovered reference(s) to Lukowski. Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While the specification provides support for a surface covering element comprising a carpet show surface having at least one layer of foam cushioning, the specification does not enable a surface covering element comprising a vinyl, ceramic, laminate or wood show surface having a foam cushioning layer. Therefore, claim 19 is rejected as being non-enabled.

5. Claims 33-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While the specification provides support for a surface covering element comprising a carpet show surface having an underside of PVC, the specification does not enable a surface covering element comprising a vinyl, ceramic, laminate or wood show surface having a PVC underside. Therefore, claims 33-36 are rejected as being non-enabled.

6. Claims 42, 43, and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While the specification provides support for a surface covering element comprising a carpet show surface having an underside of felt, the specification does not enable a surface covering element comprising a vinyl, ceramic, laminate or wood show surface having a felt underside. Therefore, claims 42, 43, and 50 are rejected as being non-enabled.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5, 6, 20, 42, 43, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,972,148 issued to Lukowski, Sr.

Lukowski discloses a process for applying a removable and releasable liner over an adhesive layer of a laminated vinyl flooring product (abstract and col. 3, lines 60-63). Said adhesive layer "has sufficient tack to secure the flooring product 11 to the subfloor, while permitting removal and repositioning of the flooring product 11 without damaging the bond between the vinyl wear layer 15 and the felt layer 14 (col. 4, lines 1-4). The adhesive is preferably an acrylic latex (col. 4, lines 19-24). Thus, Lukowshi teaches a surface covering element comprising a show surface of vinyl laminate and an underside having a "friction enhancing coating composition" exhibiting more lateral grip than an uncoated underside, wherein said coating composition does not permanently stick with little or no blocking (i.e., releasable adhesive). Hence, claims 1, 5, 6, 20, and 42 are anticipated by the cited Lukowski patent.

Regarding claims 43 and 50, said claims are also rejected since the limitation of "predrafted elliptically needled felt" is not given patentable weight at this time. Specifically, while Lukowski fails to explicitly teach a "predrafted elliptically needled felt," it is argued that this description of the felt material amounts to a method limitation in a product claim. In other words, the method steps of predrafting and elliptically needled are not believed to produce a structurally different product than the general felt taught by Lukowski. As such, the limitation of "predrafted elliptically needled felt" is not given patentable weight at this time and claims 43 and 50 are also rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 21-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Lukowski reference.

Although Lukowski does not explicitly teach the limitations of claims 21-24, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., vinyl laminate flooring having a releasable pressure sensitive adhesive of an acrylic latex thereon) used to produce the flooring product. Like materials cannot have mutually exclusive properties. The burden is upon applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed vertical adhesion properties would obviously have been provided by the process disclosed by Lukowski. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 21-24 are rejected.

11. Claims 2-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Lukowski reference.

Lukowski teaches a wet add-on level for the adhesive coating (col. 4, lines 19-20), but fails to disclose the dry add-on mass per area. However, it is reasonable to presume that said wet

add-on level would dry to the range claimed by applicant since like materials are employed for like functions. Hence, claims 2-4 are anticipated.

In the alternative, it would have been readily obvious to one of ordinary skill in the art to optimize the amount of adhesive coating applied in order to achieve the intended use of the flooring material. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215. In this case, a suitable adhesive basis weight would be determined by at least cost, degree of adhesion required, weight and flexibility of the overall product. Therefore, claims 2-4 are rejected as being obvious over the cited art.

Claim Rejections - 35 USC § 103

12. Claims 7-11, 27-30, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Lukowski reference.

While Lukowski does not explicitly teach the claimed adhesive compositions, it would have been readily obvious to one of ordinary skill in the art to substitute any of the claimed adhesives for the acrylic latex disclosed by Lukowski since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Any known adhesive that meets the functional requirements of Lukowski would be readily obvious to one skilled in the art. Therefore, claims 7-11, 27-30, and 38 are rejected.

13. Claims 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Lukowski reference in view of US 3,847,647 issued to Bahlo.

While Lukowski fails to teach application of the friction enhancing coating in a discontinuous pattern, it is well known in the art to apply adhesive coatings to carpet tiles in discontinuous patterns. For example, Bahlo discloses an adhesive backed removable carpet tile comprising a foam backing and a carpet layer (abstract). "To provide the proper release strength, the adhesive is applied to the foam backing by a figurated roller to cover between 10 and 50 percent of the foam backing." (abstract and Figures 1 and 3). Therefore, it would have been readily obvious to one of ordinary skill in the art apply the adhesive coating of Lukowski in a discontinuous pattern in order to reduce cost and/or to achieve the proper adhesive strength.

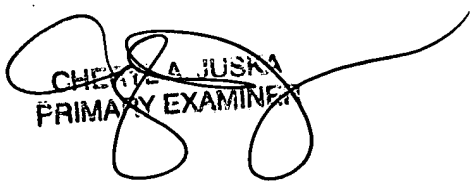
Conclusion

14. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cj
February 20, 2007